89-881

Supreme Court, U.S.
FILED
NOV 28 1989
JOSEPH F. SPANIOL, JR.
CLERK

No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1989

JAMES CONSTANT

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC.

Respondent.

A P P E N D I X

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

James Constant
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Pro se petitioner

CONTENTS

APPENDIX

A-2	Court of Appeals Judgement affirming Judgement of the District Court
A-3	Court of Appeals Order denying petitioner's motion to file supplement to amended brief already filed
B-2	District Court Order filed 27 January, 1989 holding 351 and 660 patents not infringed by AMD's 29300 and 29500 systems
B-10	District Court Order filed 16 March, 1989 holding 660 patent is invalid under 35 USC 103
B-21	District Court Order filed 4 April, 1989 denying petitioner's motion for summary judgement of infringement of the 660 patent by AMD's 7910/11 and 79C12/C14 devices,

APPENDIX

and holding that the 458 patent is not infringed by AMD

B-30 District Court Judgement filed 4 April, 1989 adjudicating that the 351 and 458 patents are not infringed by AMD, that the 660 patent is invalid, and dismissing petitioner's counterclaims with prejudice

A P P E N D I X A

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

89-1432

ADVANCED MICRO DEVICES, INC.,

Plaintiff-Respondent

v.

JAMES CONSTANT

Defendant-Petitioner

JUDGEMENT

ON APPEAL from the U.S. District Court, Northern District of California in CASE NO 88-20201-RPA. This CAUSE having been considered, it is ORDERED and ADJUDGED: Per Curiam (NIES, Circuit Judge, SMITH, Senior Circuit Judge, and NEWMAN, Circuit Judge): AFFIRMED. See Fed.Cir.R.36

ENTERED BY ORDER OF THE COURT

DATED: Oct 5 1989

Francis X. Gindhart,

Clerk

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

89-1432

ADVANCED MICRO DEVICES, INC.,

Plaintiff-Respondent

v.

JAMES CONSTANT,

Defendant-Petitioner.

ON MOTION

Before FRIEDMAN, Circuit Judge.

O R D E R

Upon consideration of the motion of James Constant for leave to file a 30-page supplement to the 49-page brief already filed,

IT IS ORDERED THAT:

The motion is denied. The total length of Constant's brief may be no longer than 50 pages.

6/26/89 Daniel M. Friedman

Circuit Judge

A P E N D I X B

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Jan 27, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff,

v.

JAMES CONSTANT,

Defendant.

ORDER GRANTING PLAINTIFF'S MOTION FOR SUMMARY ADJUDICATION AND DENYING MOTION FOR SANCTIONS AND DENYING DEFENDANT'S MOTIONS FOR SUMMARY JUDGEMENT AND SUPPRESSION OF TESTIMONY

I. INTRODUCTION

The Court has received, read, and considered the papers submitted by counsel and by Mr. Constant, both in support of and in opposition to, their respective motions. The Court also heard oral argument on all motions. GOOD CAUSE appearing therefore, the Court finds and orders as follows.

Advanced Micro Devices, Inc. (hereinafter referred to as "AMD") filed a motion for summary adjudication and a motion for Rule 11 sanctions. Mr. Constant responded to these motions, and filed his own motions for summary judgement and for the suppression of the use of his deposition testimony. Each of these motions is discussed separately below.

II. DISCUSSION

A. Motion for Summary Adjudication

AMD directs its motion for summary adjudication to two (2) patents-in-suit: Patent No. 4,006,351 (hereinafter referred to as "351") and Patent No. 4,080,660 (hereinafter referred to as "660") and contends that no products manufactured and/or sold by AMD infringe either of these patents. Constant has failed to present any evidence that either or both of hus patents have actually been infringed.

Accordingly, plaintiff's motion for summary adjudication of issues is hereby GRANTED. The following facts are established as a matter of law:

1. AMD does not sell any computer systems based on parts from its 29300 and 29500 families, but instead sells only individual parts which its customers use to create computer systems to the customer's specification.

2. A large number of possible computer systems could be built out of parts from AMD's 29300 and 29500 families. Such computer systems could be programmed to perform an infinite number of possible operations.

3. The 351 patent is infringed only by devices or systems which constitute a recursive filter implemented as a matched clutter filter.

4. None of the parts from AMD's 29300 and 29500 families constitutes a recursive

filter implemented as a matched clutter filter.

5. AMD has never created a system out of parts from its 29300 and 29500 families which constitutes a recursive filter implemented as a matched clutter filter, nor has AMD ever programmed such a system in such a manner that it operates as a recursive filter implemented as a matched clutter filter.

6. There is no evidence that any AMD customer has ever used parts from AMD's 29300 and 29500 families to create a computer system which constitutes a recursive filter implemented as a matched clutter filter.

7. AMD has never encouraged any of its customers to use parts from its 29300 and 29500 families to create any system which constitutes a recursive filter implemented as a matched clutter filter.

8. None of the parts from AMD's 29300 and 29500 families includes the elements claimed in the 660 patent.

9. AMD has never used parts from its 29300 and 29500 families to create a system such as that claimed in the 660 Patent.

10. AMD has never programmed a system built out of parts from its 29300 and 29500 families in such a manner that such system operates in the manner claimed in the 660 Patent.

11. There is no evidence that any AMD customer has ever used parts from AMD's 29300 and 29500 families to create a computer system that operates in the manner claimed in the 660 Patent.

12. AMD has never encouraged any of its customers to use parts from its 29300 and 29500 families to create any system that operates in the manner claimed in the 660 Patent.

13. AMD does not directly, contributorily or through inducement infringe the claims of the 351 Patent.

14. AMD does not directly, contributorily or through inducement infringe the claims of the 660 Patent through making, using or selling products from the 29300 and 29500 families, through making, using or selling systems based on such parts, or through encouraging its customers to make any infinging system from such parts.

15. At the trila of this Action, defendant shall be precluded from introducing evidence relating to (1) infringement of the 351 Patent; and (2) infringement of the 660 Patent by products from the 29300 and 29500 families.

B. Motion for Sanctions

Plaintiff's motion for sanctions against defendant Constant is hereby DENIED. The Court finds that defendant acted with a

reasonable, good faith belief that his actions were justified under the law.

C. Motions for Summary Judgement

Based upon the foregoing, the Court hereby DENIES defendant's motion for summary judgement based upon the infringement of Patent Nos. 351 and 660.

D. Motion for Suppression of Testimony

Apparently, the parties have resolved their dispute with respect to the deposition testimony of Mr. Constant. Mr. Constant shall make any substantive changes he wishes made to his deposition. Said changes shall be attached to Mr. Constant's original deposition, but shall not supercede or replace the original deposition testimony.

Accordingly, plaintiff need not incur any expense in changing the deposition testimony of Mr. Constant. AMD may still rely upon Mr. Constant's original deposition testimony and such testimony may be used in support of AMD's motion for summary adjudi-

cation. AMD may also, upon proper notice, re-depose Mr. Constant.

III. CONCLUSION

Based upon the foregoing, the Court hereby GRANTS plaintiff's motion for summary adjudication and DENIES plaintiff's motion for sanctions. The Court also DENIES defendant's motions for summary judgement. Defendant's motion for the suppression of deposition testimony is moot and is, therefore, DENIED.

IT IS SO ORDERED.

DATED: January 27, 1989

ROBERT P. AGUILAR
United States District
Judge

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Mar 16, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff,

v.

JAMES CONSTANT

Defendant.

ORDER GRANTING PLAINTIFF'S MOTION FOR SUMMARY ADJUDICATION AND DENYING MOTION FOR SANCTIONS

The Court has received, read, and considered plaintiff's motion for summary adjudication that Patent No. 4,080,660 (hereinafter referred to as the "660") is invalid, and the opposition thereto. The Court has also received, read, and considered both plaintiff's and defendant's requests for sanctions, pursuant to Rule 11 of the Federal Rules of Civil Procedure.

Oral argument was heard in this matter on Friday, March 10, 1989. GOOD CAUSE appearing therefore, the Court finds and orders as follows.

I. FACTUAL BACKGROUND

This matter is once again before the Court based upon a challenge to one of Mr. Constant's patents, the 660 Patent. Advanced Micro Devices, Inc. (hereinafter referred to as "AMD") contends that the 660 Patent is invalid for obviousness, based upon an earlier Federal Circuit holding, which found that Patent No. 3,950,635 (hereinafter referred to as the "635" Patent), also owned by Mr. Constant, was invalid for obviousness.

The 635 Patent discloses the use of random access memories (RAMs) in place of shift registers for use in a matched filter or correlator. The Federal Circuit held that Mr. Constant had obtained the idea for replacing shift registers with RAMs

from an article written by John Springer entitled "High Speed Shift Registers use TTL RAMs and Counters to do All the Shifting". This article was published in 1973. The article was found to have disclosed every element of the invention claimed in the 635 Patent, except the specific filter application contained in the Patent.

AMD asserts that the claims of the 660 Patent are virtually identical to those claims contained in the 635 Patent, with a few minor exceptions. The 660 Patent is a digital time scale inversion. Mr. Constant maintains that the two patents are significantly different. Both sides request that sanctions be imposed against the other, pursuant to Rule 11 of the Federal Rules of Civil Procedure.

II. LEGAL STANDARDS

Under Title 35 of the United States Code, Section 103, a patent may not be obtained if "the subject matter as a whole would have beed obvious at the time the invention was made to a person having ordinary skill in the art . . .". The Federal Circuit has held that a finding of obviousness must be supported by clear and convincing evidence sufficient to overcome a patent's presumption of validity. Constant v. AMD, 848 F.2d 1560, 1570 (Fed. Cir. 1988).

In addition, in DMI, Inc. v. Deere & Co., 802 F.2d 421,425 (Fed. Cir. 1986), the Federal Circuit held that an analysis of obviousness must include the following four elements:

1. Scope and content of the prior art;
2. Differences between the claimed invention and the prior art;
3. Level of ordinary skill in the art; and

4. Objective evidence of non-obviousness.

In reviewing the scope and content of the prior art, the Court can look not only to the Springer article, but also to the 651 Patent (discussed below), which demonstrates the use of LIFO and FIFO accounting methods. The level of skill in the art in this case is that of an engineer with a Bachelor of Science in Electrical Engineering who has had several years of experience in the field of digital electronics.

The objective evidence which is relevant to obviousness includes commercial success, long-felt but unsolved needs, failure of others, copying, and unexpected results.

III. DISCUSSION

An examination by the Court of both the 660 Patent and the 635 Patent reveals that every element found in the 660 Patent

is also found in the 635 Patent, with the exception of the application, which recites time inversion. The time inversion feature is simply the fact that data input in one order can be output in the same order or in a different order. In other words, data can be output in either a LIFO or FIFO mode.

While Mr. Constant admits that the only difference between the 660 Patent and the 635 Patent is the specific application, it is clear that Mr. Constant attempts to address the arguments raised before the Federal Circuit and seeks to have this Court "overturn" the Circuit's decision. However, the decision of the Federal Circuit is final and may only be appealed to the appropriate court, which is not this Court. Mr. Constant is collaterally estopped, as is AMD, from relitigating the decision of the Circuit. 1B J. Moore, Moore's Federal Practice, 441(2) at p.

725 (1988).

The problem now faced by the Court is determining whether or not time inversion, the only distinguishing feature between the 660 Patent and the 635 Patent, is an obvious concept. However, the Court's task is simplified by production of U.S. Patent No. 3,553,651 (hereinafter referred to as the "651" Patent), which shows the use of LIFO versus FIFO modes in a memory device. Mr. Constant's assertion that, "the 660 Patent is the first patent ever granted for a time inverter" does not appear to be true.

Based upon the foregoing, the Court hereby finds as follows:

1. There is clear and convincing evidence that all claims of the 660 Patent are invalid under 35 USC 103, because, considered as a whole, the invention disclosed in that Patent would have been obvious at the time the application was

filed to a person having ordinary skill in the art.

2. The art involved in the 660 Patent is that of digital logic systems and methods which perform signal processing. The level of ordinary skill in such art is that of an engineer with a B.S.E.E. who has had several years of experience in the field of digital electronics.

3. The prior art includes an article entitled "High-speed shift registers use TTL RAMs and counters to do all the shifting" published in 1973 by John Springer. The prior art also includes U.S. Patent No. 3,553,651 (hereinafter referred to as the "651" Patent). The patent discloses the concept of using memory devices to perform digital time scal inversion, otherwise known as "First In, First Out"(FIFO) and "Last In First Out" (LIFO) operations.

4. The Springer article discloses every element contained in claims One and Four of the 660 Patent, except for the specific application in which the invention is to be used.

5. In light of the Springer article and the 651 Patent, it would have been obvious to one skilled in the art to substitute RAMs for shift registers in the specific application disclosed in the 660 Patent ("Digital Time Scale Inversion of Signals").

6. Considering Claims One and Four of the 660 Patent as a whole, the invention disclosed in such claims would have been obvious to one of ordinary skill in the art. Therefore, such claims are invalid under 35 USC 103.

7. In light of the Springer article and the 651 Patent, it would have been obvious to use the following devices in

the system and method described in Claims One and Four of the 660 Patent: TTL, CCD, ECL, DELTIC circuit. Considering Claims Two, Three, and Five of that Patent as a whole, the invention disclosed in such claims would have been obvious to one of ordinary skill in the art. Threfore, such claims are also invalid under 35 USC 103.

8. The objective evidence does not support a finding of non-obviousness. The invention claimed in the 660 Patent has not been commercially exploited in any way. There is no evidence that that Patent has been copied, that it filled a long-felt need, or that the invention claimed led to unexpected results.

In addition, the Court hereby DENIES AMD's request for sanctions. The Court also DENIES Mr. Constant's request for sanctions, to the extent that such request was incorporated into Mr. Constant's opposition

memorandum. The Court also points out to Mr. Constant that his in limine motions will be addressed at trial and that any and all discovery disputes must be brought to the attention of Magistrate Trumbill before they may be filed before this Court.

IV. CONCLUSION

Based upon the foregoing, the Court hereby GRANTS plaintiff's motion for summary adjudication and DENIES plaintiff's request for sanctions. The Court also DENIES Mr. Constant's request for sanctions.

IT IS SO ORDERED

DATED: March 16, 1989

ROBERT P. AGUILAR

United States District Judge

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Apr 4, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff,

v.

JAMES CONSTANT,

Defendant.

ORDER GRANTING PLAINTIFF'S MOTION FOR SUMMARY JUDGEMENT AND DENYING DEFENDANT'S MOTIONS AND ENTERING FINAL JUDGEMENT

The Court has received, read, and considered both plaintiff's and defendant's motions for summary judgement. Defendant moved for summary judgement on Patent Nos. 4,107,458 (hereinafter referred to as the "458" Patent) and 4,080,660 (hereinafter referred to as the "660" Patent) and also filed a motion for summary judgement on validity issues and sanctions. Plaintiff

opposed all motions and filed its own cross-motion for summary judgement regarding the 458 Patent. The Court submitted all motions on the papers, without oral argument, at the request of defendant Constant. GOOD CAUSE appearing therefor, the Court finds and orders as follows.

The Court previously granted plaintiff's motion for summary judgement with respect to two of the three patents involved in this action, Patent Nos 4,006,351 (hereinafter referred to as the "351" Patent) and 4,080,660 (hereinafter referred to as the "660" Patent). Therefore, in so far as defendant's motions relate to the 351 and 660 patents, the Court refers defendant to the previous Orders entered in this action.

The only remaining patent in this action, then, is the 458 patent. Both plaintiff and defendant have filed a motion for summary judgement with respect to the 458

patent, with plaintiff alleging that the AMD products do not infringe the patent, while defendant argues that the products do infringe the patent. Each of the parties' arguments are discussed below.

The 458 patent entitled "Cipher Computer and Cryptographic System", enables words to be stored in a memory device. The dispute in this motion arises mainly whether or not AMD's accused products store one word, as in prior art relied on by Mr. Constant to distinguish the 458 Patent, or store more than one word, as in the 458 Patent.

Mr. Constant alleges that AMD's 9518,9568 and 8068 products infringe Claims 17,19,22,25,27, and 30 of the 458 Patent. Claims 17 and 25 are independent claims, and the remaining claims are dependent upon Claims 17 and 25. Each of the dependent claims adds an element to the independent

claim. Therefore, if AMD's products are lacking an element recited in Claims 17 and 25, they cannot infringe any of the claims. AMD asserts that its products do not infringe claims 17 and 25 since the products do not contain at least three of the elements recited in each Claim.

First, AMD contends that Claims 17 and 25 of the 458 Patent require that the first memory means store more than one word. Second, AMD asserts that the second memory means must also store more than one word. Finally, AMD argues that AMD's products do not delay, encrypt or decrypt signal K. Mr. Constant submits that the number of words in the claims is unrestricted and that the AMD products represent "one of delayed, encrypted, and decrypted signals".

AMD correctly states that, under the doctrine of file wrapper estoppel, Mr.

Constant is bound by the interpretation of his claims which he made in order to distinguish the prior art. Townsend Engineering Co. v. Hitec Co., Ltd. 829 F2d 1086,1090 (Fed. Circ 1987). During Mr. Constant's prosecution of the 458 Patent, Mr. Constant distinguished the prior art, in part, by arguing that the prior art shows memory means which stores only a single word, while his claims for the memory means store more than one.

Mr. Constant responds to this argument by stating that the explanation that he gave, while correct as stated by AMD, was with regard to the amendment to the patents, dated January 24, 1978, which was refused by the Patent Examiner. This is correct. However, Mr. Constant neglects to inform the Court that he then submitted another amendment, dated March 2, 1978,

which added an additional feature, but kept all other language from the January 24, 1978, amendment the same.

Therefore, while Mr. Constant is correct in contending that the Court should ignore his allegations with respect to the January amendment, the identical language is contained in the March amendment and the Court cannot simply ignore that language. Nor is it necessary for AMD to show that the patent examiner actually relied on this particular distinction in granting the 458 Patent. Norwood v. Ehrenreich Photo-Optical Industries, Inc., 322 F. Supp. 898,904 (C.D. Cal. 1970).

Therefore, the Court finds that, under the doctrine of file wrapper estoppel, Mr. Constant is estopped from contending that the 458 patent does not involve a memory device which stores

more than one word. With respect to this issue, then, the Court hereby GRANTS plaintiff's motion for summary judgement.

In addition, Mr. Constant points out that AMD admits storing signal K, but that AMD denies that signal K is delayed, encrypted, or decrypted. This is correct. However, Mr. Constant asserts that the act of delaying is met by outputting signal K from the key register and then inputting signal K. In other words, there is a time difference in inputting and outputting signal K and that time difference, Mr. Constant asserts, is the "delay".

AMD argues, through the declaration of one of its employees, Mr. Sudhir Bhatnagar, that this delay is not sufficient, since the claims of the 458 Patent require that signal K be read into the device, and then delayed, encrypted, or decrypted. Mr. Bhatnager declares that merely storing signal K is not

sufficient to meet the requirement that the signal be delayed, encrypted or decrypted.

Based upon the foregoing, the Court finds that the 458 Patent requires that signal K be delayed, encrypted, or decrypted before being placed in the crypto means, while the accused products merely store signal K. Therefore, the Court GRANTS plaintiff's motion for summary judgement with respect to said element.

In sum, the Court hereby GRANTS plaintiff's motion for summary judgement regarding infringement of the 458 Patent and DENIES each and every motion by defendant for summary judgement, as well as defendant's request for sanctions. Since the Court had previously ruled that the accused AMD products do not infringe U.S. Patent No. 4,006,351 and that U.S. Patent No. 4,080,660 is invalid, the

Court enters final judgement in this matter as follows:

1. U.S. Patents 4,006,351 and 4,107,458 are not infringed by AMD and that U.S. Patent 4,080,660 is invalid, and,

2. all defendant's counterclaims are dismissed with prejudice.

IT IS SO ORDERED

DATED: April 3, 1989

ROBERT P. AGUILAR

United States District Judge

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Apr 4, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff

v.

JAMES CONSTANT,

Defendant.

JUDGEMENT

Pursuant to the Order Granting Plaintiff's Motion for Summary Judgement signed April 3, 1989, Judgement is HEREBY ENTERED for Plaintiff.

IT IS SO ORDERED

DATED: April 3, 1989

ROBERT P. AGUILAR

United States District Judge

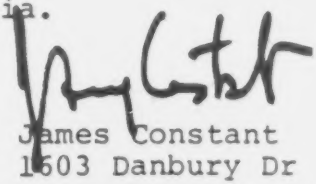
CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT and APPENDIX were served on the respondent by mailing first class Three (3) true copies to it on 27 November, 1989 addressed as follows

Skjerven, Morrill, MacPherson,
Franklin & Friel
25 Metro Drive, Suite 700
San Jose, California 95110

I declare under penalty of perjury that the foregoing is true and correct.

Executed on 27 November, 1989 at Claremont, California.



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